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#### **REMARKS**

The present Amendment and Response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

#### **Status of Claims**

Claims 1-42 are pending in the application. Claims 38 and 39 have been allowed. Claims 4 and 26 have been objected to. Claims 1-3, 5-25, 27-37, and 40-42 have been rejected. Claims 1-23, 25, 27, 32, 35, 37, 38 and 40-42 have been amended. New claims 43-47 have been added. Applicant respectfully asserts that the amendments to the claims, specification and drawings add no new matter.

New claims 43-47 have been added in order to further define what the Applicant considers to be the invention. Applicant respectfully asserts that no new matter has been added.

Voluntarily amendments have been made to claims 19, 20, 25, 38 and 42 to correct typographical errors and/or for purposes of clarification. These amendments do not narrow the scope of the claims, nor are they being made for reasons of patentability. These amended claims are not subject to the complete bar against the use of the Doctrine of Equivalents as outlined in *Festo Corporation v. Shoketsu Kinsoku Kogyo Kapushiki Co., Ltd. a/ka/ SMC Corporation and SMt Pneumatics, Inc.*

#### **Allowable Subject Matter**

Applicant thanks the Examiner for allowing claims 38 and 39. Applicant further thanks the Examiner for indicating in the Office Action, that claim 19 would be allowable if re-written or amended to overcome the rejection thereof under 35 U.S.C. 112, and for indicating that claims 4 and 26 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### **Remarks to the Drawings**

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Fig. 1 has been amended to renumber interaction chamber as 22 to match the numbering thereof in the specification.

### **Interview Summary**

Initially, Applicant wishes to thank Examiner, Mr. Jonathan M. Foreman, and Examiner Max F. Hindenburg for granting and attending the in-person interview on October 22, 2003 with Applicant's representative, Caleb Pollack, Reg. No. 37,912, attorney of record for Applicant, and Rachel Bentov, a representative of Applicant's assignee.

Applicant's representatives discussed with the Examiners the proposed draft claim amendments sent by facsimile to the Examiner prior to the interview. Applicant's representatives also discussed with the Examiners prior art cited by the Examiner in the subject office action, particularly U.S. Pat. No. 5,582,170 to Soller, U.S. Pat. 6,498,941 to Jackson and U.S. Pat. No. 6,330,465 to Huyberechts. Applicant notes that while several sample claims were submitted in the facsimile, Applicant may choose to prosecute some or all of these claims at a later date, but that non-prosecution of these claims is not meant to be an indication that the subject matter of these claims is being given up. Applicant's representatives and the Examiners agreed on claim amendments that overcame the prior art rejections of record. The amendments submitted in this Amendment and Response include, inter alia, the agreed upon claim amendments.

The Examiners and Applicant's representatives agreed that the term "in situ" as used in the claims would be replaced with "in vivo".

### **Voluntary Amendments**

Applicant has voluntarily amended claim 20 to correct a mistake in the reference number of such claim.

Applicant has voluntarily amended claims 27, 32 and 35 by adding thereto, the words "the method" to clarify that the elements listed in such claims are elements of the method and to clarify what Applicant regards as the invention.

Applicant has voluntarily amended claims 25 and 37 by replacing the term "in situ" with the term "in vivo" to clarify what Applicant regards as the invention.

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Applicant has voluntarily amended claims 19, 21, 38, 40 and 42 to correct the punctuation therein.

Since these amendments were not made for reasons of patentability and do not narrow the scope of the respective claims, these amendments are not subject to the complete bar against the use of the doctrine of equivalents as outlined in *Festo Corporation v. Shoketsu Kinsoku Kogyo Kabushiki Co. Ltd.*

### **Claim Objections**

In the Office Action, the Examiner objected to claims 4 and 26 as being dependent on a rejected base claim, but the Examiner indicated that each of such claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 4 depends from independent claim 1. As discussed more fully below, independent claim 1 is now allowable. Applicant therefore requests the removal of the objection to claim 4 as being dependent on a rejected base claim. Claim 26 depends from independent claim 25. As discussed more fully below, independent claim 25 is now allowable. Applicant therefore requests the removal of the objection to claim 26 as being dependent on a rejected base claim.

### **CLAIM REJECTIONS**

#### **35 U.S.C. § 112 Rejections**

In the Office Action, the Examiner rejected claim 19 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which Applicant regards as the invention. In response, Applicant has amended claim 19 to correct typographical errors and clarify what the Applicant regards as the invention. Applicant respectfully asserts that these amendments render claim 19 proper under 35 U.S.C. 112 and requests that the rejection be withdrawn. Claim 20 depends directly from independent claim 19 and includes all of the elements of claim 19. Applicant therefore asserts that claim 20 is allowable. Applicant was uncertain from paragraph 3 of the Office Action whether claim 20 had been rejected by the Examiner.

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Since the amendments to claims 19 and 20 do not narrow the scope of the respective claim, this amendment is not subject to the complete bar against the use of the doctrine of equivalents as outlined in *Festo Corporation v. Shoketsu Kinsoku Kogyo Kabushiki Co. Ltd.*

### 35 U.S.C. § 102 Rejections

In the Office Action, the Examiner rejected claims 1, 2, 7, 8, 15, 27 and 28 under 35 U.S.C. § 102(b), as being anticipated by U.S. Pat. No. 5,582,170 to Soller ("Soller"). Applicant respectfully traverses the rejections of claims 1, 2, 7, 8, 15, 27 and 28 under 35 U.S.C. § 102(b), as being anticipated by Soller in view of the remarks that follow.

During the October 22 interview, the Examiners and Applicant's representatives agreed on amendments that would overcome the prior art of record.

Applicant's independent claim 1, as amended, includes, inter alia, "An autonomous device configured for being capable of passing through a body lumen". Applicant's independent claim 27, as amended, includes inter alia "an interaction chamber that is disposed in an autonomous device, the device capable of passing through a body lumen". Soller does not disclose an autonomous device configured for being capable of passing through a body lumen or otherwise capable of "passing through a body lumen", as is variously recited in Applicant's independent claims 1 and 27, as amended. In order for a reference to anticipate a claim under 35 U.S.C. 102(b), the reference must teach every element of the claim being rejected. Applicant asserts that Soller does not teach every element of the Applicant's independent claims 1 and 27, as amended. Applicant therefore asserts that independent claims 1 and 27, as amended are not anticipated by Soller. Applicant respectfully requests that Examiner withdraw the rejection of independent claims 1 and 27, as amended, as being anticipated by Soller.

As discussed, Applicant's independent claims 1 and 27 are allowable. Dependent claims 2, 7, 8, 15 and 28 depend from one of independent claims 1 or 27, and thereby include all of the elements of these claims. Therefore, Applicant respectfully requests that the Examiner withdraw his rejection of dependent claims 1, 2, 7, 8, 15 and 28.

In the Office Action, the Examiner rejected claims 1-3, 5, 6, 9-18, 21-25, 27-31 and 40-42 under 35 U.S.C. § 102(e), as being anticipated by U.S. Pat. No. 6,498,941 to Jackson

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("Jackson"). Applicant respectfully traverses the rejections of claims 1-3, 5, 6, 9-18, 21-25, 27-31 and 40-42 under 35 U.S.C. § 102(e), as being anticipated by Jackson in view of the remarks that follow.

Applicant's independent claims 1, 21, 22, 23, and 25 as amended, include, inter alia, "An autonomous device configured for being capable of passing through a body lumen". Applicant asserts that Jackson does not disclose "An autonomous device configured for being capable of passing through a body lumen" as is recited in Applicant's independent claims 1, 21, 22, 23, and 25, as amended. In order for a reference to anticipate a claim under 35 U.S.C. 102(e), the reference must teach every element of the claim being rejected. Further to the agreement between representatives of Applicant and Examiner at the interview described above, Applicant asserts that Jackson does not teach every element of the Applicant's independent claims 1, 21, 22, 23, and 25, as amended. Applicant therefore asserts that independent claims 1, 21, 22, 23, and 25, as amended are not anticipated by Jackson. Applicant respectfully requests that the Examiner withdraw the rejection of independent claims 1, 21, 22, 23, and 25, as amended, as being anticipated by Jackson.

As discussed, Applicant's independent claim 1 is allowable. Dependent claims 2-3, 5, 6, and 9-18 depend directly from independent claim 1, and thereby include all of the elements of independent claim 1. Applicant's independent claim 23 is allowable. Dependent claim 24 depends directly from independent claim 23, and thereby includes all of the elements of independent claim 23. Therefore, Applicant respectfully requests the Examiner to withdraw his rejection of dependent claims 2-3, 5, 6, 9-18 and 24 as being anticipated by Jackson.

Applicant's independent claims 27, 40 and 42 as amended, include, inter alia, "an interaction chamber that is configured in an autonomous device capable of passing through a body lumen". Applicant asserts that Jackson does not disclose "an interaction chamber that is configured in an autonomous device capable of passing through a body lumen". In order for a reference to anticipate a claim under 35 U.S.C. 102(e), the reference must teach every element of the claim being rejected. Further to the agreement between representatives of Applicant and Examiner at the interview described above, Applicant asserts that Jackson does not teach every element of the Applicant's independent claims 27, 40 and 42, as amended. Applicant therefore asserts that independent claims 27, 40 and 42, as amended are not

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anticipated by Jackson. Applicant respectfully requests that Examiner withdraw the rejection of independent claims 27, 40 and 42, as amended, as being anticipated by Jackson.

As discussed, Applicant's independent claim 27 is allowable. Dependent claims 28-31 depend directly from independent claim 27, and thereby include all of the elements of independent claim 27. Therefore, Applicant respectfully requests the Examiner to withdraw his rejection of dependent claims 28-31 under 35 U.S.C. § 102(e).

As discussed, Applicant's independent claim 40 is allowable. Dependent claim 41 depends directly from independent claim 40, and thereby includes all of the elements of independent claim 40. Therefore, Applicant respectfully requests the Examiner to withdraw his rejection of dependent claim 41.

### **35 U.S.C. § 103 Rejections**

In the Office Action, the Examiner rejected claims 32-37 under 35 U.S. 103(a) as being unpatentable over Jackson in view of U.S. Pat. No. 6,330,465 to Huyberechts et al ("Huyberechts").

Applicant respectfully traverses the rejection of claims 32-37 under 35 U.S. 103(a) as being unpatentable over Jackson in light of Huyberechts.

Applicant has amended independent claims 32 and 35 to include inter alia "an interaction chamber that is configured in an autonomous device capable of passing through a body lumen". Applicant asserts that neither Jackson nor Huyberechts, alone or in combination, teach or suggest, "an interaction chamber that is configured in an autonomous device capable of passing through a body lumen", as is required in the Applicant's independent claims 32 and 35, as amended.

An obviousness rejection requires a teaching or a suggestion by the relied upon prior art of all the elements of a claim (M.P.E.P. §2142). Since neither Jackson nor Huyberechts, alone or in combination teach or suggest all the elements of either of claims 32 or 35, as amended, neither Jackson nor Huyberechts, alone or in combination, renders either of claims 32 or 35 obvious.

As discussed, claims 32 and 35, as amended are allowable. Since dependent claims 33-34 depend directly or indirectly from claim 32, as amended, and include all of the

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elements of claim 32, Applicant asserts that dependent claims 33-34 are allowable. Since dependent claims 36-37 depend directly or indirectly from claim 35 and include all of the elements of claim 35, Applicant asserts that dependent claims 36-37 are allowable.

Thus Applicant respectfully requests that the rejection of claims 32-37 under 35 U.S. 103(a) as being unpatentable over Jackson in light of Huyberechts be withdrawn.

#### **New Claims**

Applicant has added new claims 43-47 to clarify what Applicant regards as the invention.

With regard to new claims 43-47, none of the prior art of record alone or in combination teaches the limitations of such new claims. Applicant asserts that such new claims 43-47 are allowable.

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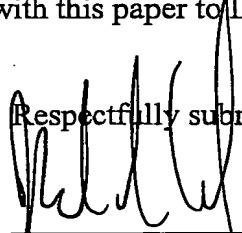
### Conclusion

In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any questions or comments as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

As discussed above, Applicant is separately requesting a one month extension of time. Please charge the \$45 due for the 5 new dependent claims 43 -47 (\$9 small entity fee x 5 claims) and any additional fees associated with this paper to Deposit Account No. 05-0649.

Respectfully submitted,

  
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Mark S. Cohen  
Attorney for Applicant(s)  
Registration No. 42,425

Dated: December 15, 2003

**Eitan, Pearl, Latzer & Cohen Zedek, LLP.**  
10 Rockefeller Plaza, Suite 1001  
New York, New York 10020  
Tel: (212) 632-3480  
Fax: (212) 632-3489





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Amdt. Dated November 14, 2003  
Reply to Office action of August 15, 2003  
Replacement Sheet

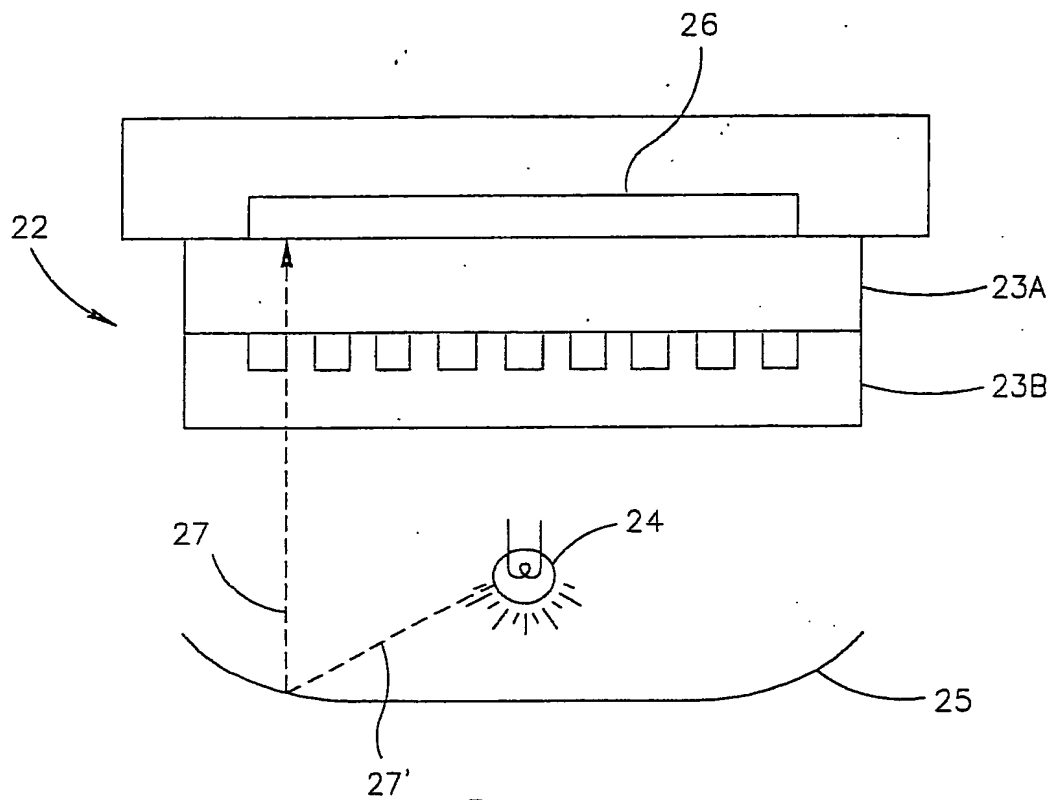


FIG.1



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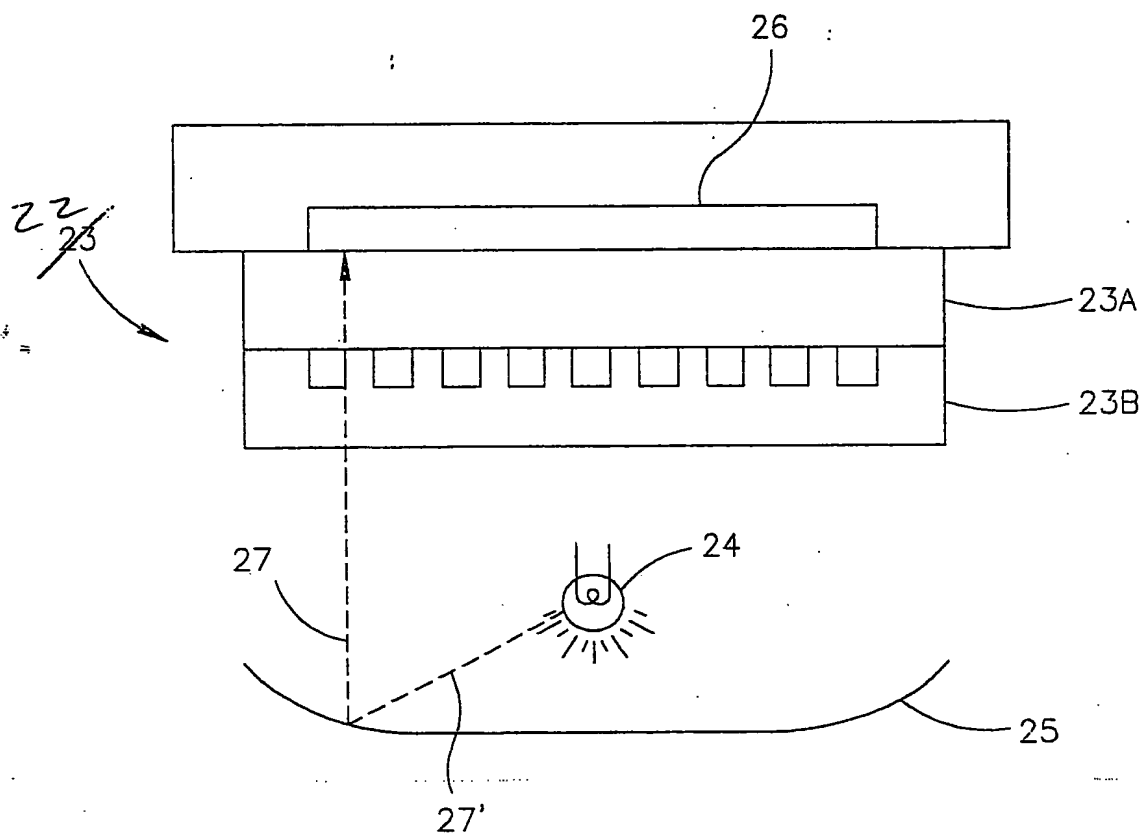


FIG.1